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| EXAMINER | |
|---|---|
| MADDEN, GREGORY VINCENT | |
| **ART UNIT** | **PAPER NUMBER** |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/055,902 | KOYAMA, SHINICHI | |
| | Examiner | Art Unit | |
| | Gregory V. Madden | 2622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8,13 and 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,13 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *JP 11-308568*.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments (see Amendment After Final, filed September 7, 2007) with respect to the rejection(s) of claim(s) 1 and 5 under Miyaji, Saito et al., and Official Notice have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, and in view of the IDS filed by the Applicant on September 19, 2007, a new ground(s) of rejection is made in view of Miyaji (U.S. Pat. 5,206,739), Saito et al. (U.S. Pat. 6,184,922) and Nakamura et al. (JP 11-308568).

Noting Pg. 4 of the Applicant's Remarks filed on September 7, 2007, the Applicant argues that the Miyaji reference fails to teach or suggest "stopping *providing* the image and sound data", as Miyaji does not discontinue supplying the video signal to the external recording unit. The Examiner agrees that Miyaji alone does not teach that the image and sound data is stopped from being provided to the external recording unit via the communication unit. Miyaji only teaches that the recording of the external recording unit is stopped in response to the record stop instruction. Thus, as noted above, the previous rejection is withdrawn. However, in view of the IDS submitted by the Applicant on September 19, 2007, the Examiner believes that the Nakamura reference sufficiently teaches that data is stopped from being provided (or outputted) from a communication unit between an image capture unit (digital camera) and an external storage device (personal computer) in response to a record stop instruction. Please refer to the new ground of rejection to claims 1 and 5 set forth below in greater detail.

Next, it is noted that the Applicant requests that a reference be provided regarding the Official Notice as to the obviousness of incorporating a microphone unit into the system of claims 1 and 5. With the addition of the Nakamura reference in view of Miyaji and Saito et al, where Nakamura teaches a

microphone unit, the previous rejection is withdrawn, and thus the Applicant's arguments are considered moot.

Finally, please note that the possible Examiner's Amendment discussed in the personal interview with the Applicant's representative (see Interview Summary of 9/18/2007, wherein the term "providing" was to be replaced with the term "outputting") will not be entered at this time. However, regardless of the possible amendment, the Examiner believes that the newly cited Nakamura reference reads on both "...stopping *providing* the image and sound data" and/or "...stopping *outputting* the image and sound data". Again, please refer to the rejection to claims 1 and 5 set forth below.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-8 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyaji (US 5,206,739) in view of Saito et al. (US 6,184, 922), further in view of Nakamura et al. (JP 11-308568).**

Regarding **claim 1**, Miyaji discloses an image capture apparatus comprising an image capture unit adapted to capture an image and output image data (col. 3 lines 8-15), an internal recording unit (fig. 1 indicator 1) adapted to (a) start recording the image on a recording medium in response to a record start instruction, and (b) stop recording the image on the recording medium in response to a record stop instruction (col. 3 lines 45-62), and a communication unit being capable of connecting with an external

storage device and outputting the image (fig. 1), wherein said communication unit starts outputting the image in response to the instruction of starting recording (col. 5 line 62 -col. 6 line 8), and wherein said communication unit stops recording the image in response to an instruction of stopping recording (col. 5 line 62 - col. 6 line 8). Miyaji also discloses a control unit (fig. 1 indicator 6) adapted to determine whether the internal recording unit becomes unable to record the image data when the communication unit is outputting the image data (outputting video signals to the external recording unit 2), as well as discloses wherein if it is determined that said internal recording unit becomes unable to record the image data on the recording medium (internal recording unit 1) when the communication unit is outputting the image data, the control unit stops recording the image data on the external recording unit (2) in response to the record stop instruction (col. 5, line 10 – col. 6, line 26).

However, while Miyaji discloses operation of the external storage unit based on circuitry state, which inherently implies connectivity for any high-signal states to exist, the reference does not disclose the image capture apparatus making an explicit determination that the external storage device is connected. Nor does Miyaji disclose enabling output of data in response to a record start instruction if it is determined that the external storage device is connected. Also, while Miyaji teaches that the external storage device stops recording image data in response to a record stop instruction, Miyaji fails to teach that the control unit stops providing image and sound data from the communication unit to the external storage device in response to the record stop instruction. Miyaji also fails to explicitly disclose a microphone unit or associated sound data.

Nevertheless, the Saito reference discloses an image capture apparatus with the capability of determining if an what external storage device is connected (col. 5, line 66 – col. 6, line 29), as well as discloses the use of an IEEE 1394 interface (col. 12, lines 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the determination of connectivity of an external storage device in order to allow for indication of the type of external storage

device (in the case of Saito, either still image or motion image capabilities; and particularly the "plug-n-play" functionality of the IEEE 1394 interface connectivity, which allows for automatic recognition of a connected device and reconfiguration according to this awareness), or as means to indicate to a user that an external device if actually functionally connected. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to incorporate determination of connectivity, as taught by Saito, with the control functionality of the internal/external recording unit of Miyaji in order to conserve power via reduced processing when the external device is not found to be connected, as well as to take advantage of the reduced user interaction provided by the plug-n-play functionality.

Finally, while both Miyaji and Saito fail to explicitly disclose that the control unit stops providing image and sound data to the external recording unit in response to the record stop instruction, as well as fail to disclose a microphone unit or associated sound data, the Nakamura reference teaches an image capture unit (digital camera 2) connected via a communication unit (USB terminal 13) with an external storage device (personal computer), wherein when a record stop instruction (via recording termination carbon button) is provided, the control unit (microcontroller 211) stops providing (or outputting) data from the communication unit to the external storage device (see Paras. [0028-0030]). Further, Nakamura teaches that the image capture unit comprises a microphone unit (Microphone Media Interface Connector) that is adapted to output sound data (Para. [0025]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated both the stopping of providing data to the external recording unit in response to the record stop instruction as well as the microphone unit, as taught by Nakamura, with the image capture apparatus of Miyaji in view of Saito. One would have been motivated to stop providing the data (be it sound or image data, or both) to the external recording unit in response to the record stop instruction because providing (or outputting) data to an external recording unit when that data is not desired to be recorded only serves to waste power resources of the image capture unit. Further, by incorporating the recording of sound data via a microphone unit, the image capture unit

is able to capture a more representative rendition of a recorded event, as opposed to a recording having only image data.

Regarding **claim 2**, Miyaji in view of Saito further in view of Nakamura teaches the limitations of claim 1 above, and Miyaji further teaches that even if the internal recording unit (1) becomes unable to record the data on the recording medium, the control unit does not discontinue output of the data from the communication unit. Please refer to Col. 5, Line 62 – Col. 6, Line 26.

As for **claim 3**, the limitations of claim 1 are again set forth above, and the Saito reference further discloses that the communication unit outputs the data using an isochronous transfer conformed to IEEE 1394-1995 standards, as shown in Col. 12, Lines 48-50.

In regard to **claim 4**, the limitations of claim 1 are taught above, and Saito teaches that the image capture apparatus is a camera-integrated digital video recorder. Note Col. 4, Lines 37-44 and indicator 4 of Fig. 1, wherein the camera can be integrated with a DVD-R or DVD-RAM drive.

Considering **claim 13**, again the limitations of claim 1 are taught above, and Saito further discloses that the image and sound data is conformed to an MPEG2 transport stream, as is taught in Col. 19, Lines 59-63.

Finally, regarding **claims 5-8 and 14**, although the wording is different, the material is considered to be substantively equivalent to that of claims 1-4 and 13, respectively, and is therefore rejected as discussed above.

### *Conclusion*

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on September 19, 2007 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory V. Madden whose telephone number is 571-272-8128. The examiner can normally be reached on Mon.-Fri. 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Yen Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory Madden
September 24, 2007

NGOC-YEN VU
SUPERVISORY PATENT EXAMINER